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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,160	12/28/2001	Bertus Karel Edens	029150-118	5213

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,160

Applicant(s)

EDENS ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/7/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on December 28, 2001.

Claims 1-14 are pending. Claims 1-14 are examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said generated code represents the combination of the registered item-type properties" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 is rejected for incorporating the errors of its respective base claim 3 by dependency.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-11 only recite an abstract idea. The recited steps of merely assembling mail pieces does not apply, involve, use, or advance the technological arts since all of the recited steps **can be performed in the mind of the user or by use of a pencil and paper**. These steps only constitute an idea of how to assemble mail pieces over another.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention assembles mail pieces (i.e., useful, concrete and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-11 are deemed to be directed to non-statutory subject matter. Applicant is advised to implement technologies in the claims, such as change the phrase "generating a code..." to "electronically generating a

code...", change the phrase "comparing said code ..." to "electronically comparing said code...", etc.

As to claim 12, applicant claims functional descriptive material – a computer program for setting a system for producing mails pieces. According to MPEP 2106 IV B 1 (a), "data structure not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer". Applicant is advised to embody the computer program in a computer readable media.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hart, Jr. et al., U. S. Patent 6,714,835.

As to claims 1 and 12, Hart teaches a method for machine-producing a series of mail pieces with the aid of a system for assembling mail pieces, comprising traversing a start-up phase, and a computer program for setting a system for producing mail pieces, comprising (abstract):

- a) the system registering at least one property of at least one physical, postal item of a particular type (column 3 line 67 – column 4 line 4 and column 4 lines 25-36 and Figs. 3A, 3C);
- b) generating a code representing the at least one registered property (column 5 lines 13-17 and Figs. 3A-3B, 4; *specifically, this limitation corresponds to the job ID of the header 82 in Hart's teaching*);
- c) comparing said code representing the at least one registered property with at least one reference code, stored in a memory, which represents at least one item-type property (column 5 lines 18-26 and Figs. 2, 3A-3B, 4);
- d) in response to at least a defined extent of agreement between said code representing the at least one registered property and the reference code or at least one of the reference codes, selecting at least one setting code, associated with said reference code or at least one of the reference codes, which represents a system setting (column 5 lines 18-26 and Fig. 4 *specifically, "selecting at least one setting code" corresponds to input the mailing control file in Hart's teaching*);
- e) during an operating phase following said start-up phase, producing a series of mail pieces with items of said item-type in accordance with the selected setting code (column 5 lines 27-53 and Fig. 4).

As to claim 2, Hart further teaches a setting phase prior to said registration of at least one property of at least one physical, postal item, comprising: inputting at least one reference code representing at least one item-type property; inputting at least one setting code representing at least one system setting; and

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storing said reference code and said setting code in mutually coupled relation (column 4 lines 6-15, 59-65 and Figs. 1, 3B).

As to claims 3-4, Hart teaches registering at least two item-type properties, wherein: said generated code represents the combination of the registered item-type properties (column 5 lines 18-53 and Figs. 2, 3B, 4; *specifically, "at least two item-type properties" corresponds to documents, inserts, envelopes, etc. in Hart's teaching, and "codes represents the combination of the registered item-type properties" corresponds to the set-up parameter values that specifying what documents, inserts, envelopes should be used for assembling the mail*); a setting code is selected if said generated code exhibits at least a defined extent of agreement with a reference code coupled thereto which represents a combination of at least two item-type properties (column 5 lines 41-53 and Fig. 4; *specifically, this limitation is taught by Hart as the mailing job is selected if the generated code matches the current setting code*).

As to claim 5, Hart teaches selecting a setting code comprises:

a) preselecting at least two setting codes each representing a system setting, said setting codes each being coupled to a reference code which exhibits at least a defined extent of agreement with said code generated starting from the registered at least one item-type property (column 3 line 67 – column 4 line 24 and Fig. 3A-3B; *specifically, "at least two setting codes" corresponds to the plurality of mailpiece records in Hart's teaching, and "a reference code" corresponds to the Job ID*);

b) selecting a setting code from said preselected setting codes (column 5 lines 13-27 and Fig. 4).

As to claim 6, Hart teaches representing said preselected setting codes, or said system settings represented thereby, in humanly perceptible form; wherein selecting a setting code from said preselected setting codes consists in inputting a choice from said represented setting codes or said system settings represented thereby (column 3 line 67 – column 4 line 36 and Figs. 3A-4).

As to claim 7, Hart teaches selecting a setting code from said preselected setting codes is done depending on agreement between system settings represented by said preselected setting codes and a current system setting (column 5 lines 13-53 and Fig. 4).

As to claim 8, Hart teaches selecting a setting code from said preselected setting codes is done depending on agreements between item types associated with system settings represented by said preselected setting codes and item types present in the system (column 5 lines 13-53 and Fig. 4).

As to claim 9, Hart teaches registering at least one item-type property is done in the area of a feeder station of the system (column 4 lines 5-11 and column 5 lines 41-53).

As to claim 10, Hart teaches determining a difference between a current condition of the system for assembling mail pieces and a required loading condition for assembling mail pieces in accordance with said system setting associated with said at least one selected setting code, and representing an indication associated with said difference (column 5 lines 41-53).

As to claim 13, Hart teaches a system for producing a series of mail pieces comprising (abstract):

- a) at least one station for processing postal items into a mail piece (abstract and Fig. 2);
- b) a sensor, for registering at least one type-property of an item (abstract and column 3 line 67 – column 4 line 4 and column 4 lines 25-36 and Figs. 1-2, 3A, 3C);
- c) a control structure communicatively linked with said sensor for receiving signals coming from said sensor, which signals represent at least one type property of an item (abstract and column 5 lines 28-53 and Fig. 2);
- d) a memory for storing at least one reference code representing an item-type property and at least one setting code representing a system setting associated with said item-type property, which memory is communicatively linked with said control structure (column 4 lines 5-15 and column 5 lines 18-26 and Figs. 2, 3A-3B, 4);
- e) wherein the control structure is arranged for traversing a start-up phase comprising: comparing signals coming from the sensor with said reference code or reference codes stored in the memory, and in response to at least a defined extent of agreement between said code representing the at least one registered property and the reference code or at least one of the reference codes, selecting at least one setting code, associated with

said reference code or at least one of the reference codes, which represents a system setting (column 5 lines 18-26 and Fig. 4); and
f) for controlling, during an operating phase following said start-up phase, said at least station for producing a series of mail pieces from items of said item type with the system set in accordance with the selected setting code (column 5 lines 27-53 and Fig. 4).

As to claim 14, Hart teaches at least one feeder station for feeding postal items, wherein said sensor for registering at least one item-type property is located in the area of said feeder station (abstract and column 4 lines 5-11 and column 5 lines 41-53).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart, Jr. et al., U. S. Patent 6,714,835 in view of Breese et al., U. S. Patent 6,353,813.

As to claim 11, Hart teaches determining at least two differences between a current loading condition of the system for assembling mail pieces and at least two required loading conditions for assembling mail pieces in accordance with at least two of said system settings associated with at least two of said selected setting codes (column 3 line 67 – column 5 line 53 and Figs. 3A-4).

Hart does not specifically teach determining a lesser one of said two differences, and selecting as first one, one of said at least two selected setting codes that belongs to a system setting for which the difference between the required loading condition and the current condition of the system for assembling mail pieces is the lesser. However, Breese teaches determining a better match to common attributes (abstract and column 7 lines 34-37 and column 8 lines 34-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the different settings in Hart's teaching to include the feature of determining a better match as taught by Breese for helping the operator determine better settings. Furthermore, it would have been obvious to one of ordinary skill in the art to allow the teaching of Hart modified by Breese to include the feature of determining and selecting the settings that is more close to a predetermined setting for better assisting the operator to choose better settings.

Conclusion

10. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ramsey (U. S. Patent 5,157,617) discloses assembling apparatus including means for matching coded sheets.

Ryan, Jr. (U. S. Patent 6,173,274) discloses production mail system having subsidies for printing of third party messages on mailpieces.

Hidding et al. (U. S. Patent 6,412,255) discloses assembling mail items with selective envelope selection.

Koster et al. (EP 1 084 978 A1) discloses setting a system for assembling mail items.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
November 2, 2004

